

19. (New) The method of claim 10 further comprising the steps of:
sorting the application program functionality according to a frequency of
occurrence.
20. (New) The method of claim 19 wherein the step of sorting the application
program functionality comprises steps of:
causing the handler to return importance rankings associated with the application
program functionality.
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REMARKS

Claims 1-6, and 8-20 are pending in the application. Claims 1, 4, and 8 have been amended. New claims 12-20 have been added. Support for claims 12-20 can be found on pages 11-15 of the Application as filed. Claim 7 has been cancelled without prejudice.

Applicant's Invention

The present invention relates generally to methods and systems for identifying files that a user of a client computer may need when the client computer is disconnected from a network. The files may be automatically or manually identified and may be related to file usage patterns. In order to execute the identified files on the client computer when it is disconnected from the network, a handler associated with each file type identifies application software that may be required to execute each of the files. Each of the files and their associated application software is downloaded to the client computer. The handlers may provide importance rankings for the application software. In addition, embedded files may be identified and sent to handlers so that application software for embedded files may be identified and downloaded in order to execute embedded files.

Cited Reference

The Office Action relies on Patent No. 5,859,969 by Oki et al. (the Oki patent) and Patent No. 6,195,678B1 by Komuro (the Komuro patent). The Oki patent describes a system for

distributing software over a network to a client based on the client hardware and operating system. The Komuro patent describes a system that downloads resources that are most suitable for an application that is requested by a user. The Oki and Komuro systems do not individually or in combination describe a system with a handler specifically associated with each file, whereby each handler is operable to identify application software necessary to execute the associated file when the client is disconnected from the network. The Oki and Komuro systems also fail to describe handlers that are operable to identify an embedded file within a file and a method of sending an embedded file to a handler associated with the embedded file.

Rejections of claims 1 under 35 U.S.C. § 112, second paragraph

Claim 1 has been amended to resolve any issue with regard to insufficient antecedent basis. As such, the Applicant earnestly requests removal of the rejection of claim 1 under 35 U.S.C. § 112.

Rejections of claims 1-3, and 6-11 under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-3 and 6-11 as being unpatentable over the Komuro patent in view of the Oki patent, and further in view of the Applicants' disclosure. The Examiner rejected claims 6-9 as being unpatentable over the Oki patent in view of the Komuro patent. The Examiner rejected claims 10-11 as being unpatentable over the Komuro patent in view of the Applicants' disclosure.

In order for claims to be rendered obvious in light of a cited reference, there must be some suggestion or motivation to modify the reference, there must be a reasonable expectation of success, and the prior art reference must teach or suggest all the claim limitations. (See MPEP § 2143). The Applicants traverse the Examiner's rejections of claims 1-3, 6, and 8-11 because the Examiner has not established a prima facie case of obviousness.

Claims 1-3

The Examiner asserts that Komuro teaches sending each file to an identified handler routine. The Examiner asserts that the server computer A2 of the Komuro patent is a handler routine. The Applicants' traverse these arguments.

Amended claim 1 recites, in part, a method for identifying application functionality needed to run a set of files when a computer is disconnected from a network, by identifying a handler routine for each file and sending each file to the identified handler routine; and in the identified handler routine, determining application functionality required to execute each file. The handler of the present application is specific to the handler's associated file type. (See Application, p. 10, line 34). Each file is sent to the proper handler routine, which understands the particular type of file. (See Application, p. 12, lines 12-14.)

In contrast to the handler of claim 1, the computer A2 in Komuro is not specific to an associated file type. The computer A2 consults a resource linkage management means C1. (See Komuro, col. 4, lines 57-60). The resource linkage management means C1 uses a database to retrieve information about a resource that most fits an application selected by a user. Thus, the computer A2 of Komuro does not teach or suggest a handler as recited in claim 1.

The Examiner asserts that the Komuro patent is silent with reference to a set of files and application program functionality but that the Oki patent teaches a set of files and that one would have been motivated to apply the teaching of Oki to the system of Komuro. The applicants traverse this argument.

In addition, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings. (See MPEP 2143.01). In establishing motivation, the suggestion to combine must stem from the prior art itself, as a whole. (See MPEP 2143.01). The Examiner has not provided any facts as to why organizing and storing sets of files is suggested by the prior art, as a whole.

Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. (See MPEP 2143). Any obviousness analysis must be made "at the time the invention was made." (See MPEP 2141). The Examiner's assertion that organizing files into sets

of files makes for better memory or resource management is based on the applicant's disclosure. The Examiner's assertion that one would have been motivated to modify Komuro such that application functionality includes products, features or components, is found in the applicants' disclosure. With regard to claim 3, the Examiner's assertion that identifying files and storing them on the computer are logical steps of providing file resources to a remote computer, is found in the applicants' disclosure. Thus, the Examiner has used impermissible hindsight to reject claims 1-3 as obvious.

The Examiner has not established a prima facie case of obviousness with regard to claims 1-3. Claim 1 is believed to be allowable over the art of record for at least the reasons stated herein, and prompt allowance is earnestly requested. Claims 2 and 3 depend from claim 1, and therefore inherit all the limitations of claim 1. Therefore, claims 2 and 3 are believed to be allowable for at least the same reasons that claim 1 is allowable.

Claims 6-9

Claim 7 has been cancelled. Claim 8 has been amended to more clearly recite the Applicants' invention.

Claim 6 recites a method for identifying a set of files and application functionality needed to run the set of files when the computer is disconnected from a network by, in part, searching a plurality of files in a plurality of storage locations on the computer, determining whether each file found in the plurality of storage locations is to be stored locally on the computer, and, if so, adding the file to the set of files.

The Examiner asserts that Oki is silent with reference to a plurality of storage locations on the computer, but that Komuro teaches a plurality of storage locations, and that one would have therefore been motivated to apply the teachings of Komuro to the system in Oki. The Applicants traverse the Examiner's arguments.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. (See MPEP 2143). Any obviousness analysis must be made "at the time the invention was made." (See MPEP 2141). The Examiner is relying on the Applicants' disclosure in the assertion that one would have been motivated to use a plurality of storage locations. Thus, the Examiner has

used impermissible hindsight to reject claims 6-9 as obvious.

In addition, claim 6 depends from claim 4 (discussed below), and therefore includes all the claim limitations of claim 4. Claim 6 is therefore believed to be allowable over the art of record for at least the same reasons as claim 4. Claims 8 and 9 depend from claims 4 and 6 and therefore include all the limitations of claims 4 and 6. Claims 8 and 9 are therefore believed to be allowable for at least the same reasons as claims 4 and 6. Prompt allowance of claims 6, 8, and 9 is earnestly requested.

Claims 10-11

Claim 10 recites a method for identifying a set of application functionality to be stored on a computer connected to a network by causing a document identification engine (DIE) to create a list of a plurality of files stored locally on the computer, sending the list of files from the DIE to a document mapping engine (DME), causing the DME to identify a proper handler routine for each file in the list of files, sending each file from the DME to the proper handler routine, causing the handler routine to identify the application functionality needed to execute each file, sending a list of needed application program functionality of the handler routine to the DME, sending a list of needed application program functionality from the DME to a migration engine (ME), causing the ME to determine the current status of the needed application functionality, and if the status of the needed application functionality indicates that the needed application functionality is not installed locally on the computer, then causing the ME to install the needed application functionality to the computer.

The Examiner asserts that the Komuro patent is silent with reference to a list of needed application program functionality. The Examiner asserts that the Applicants' disclosure teaches a list of application program functionality and it would have therefore been obvious to apply the teaching of the Applicants' disclosure to the Komuro system. The applicants traverse this argument.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. (See MPEP 2143). Any obviousness analysis must be made "at the time the invention was made." (See MPEP 2141). The Examiner is relying on the Applicants' disclosure to assert that one

would have been motivated to utilize a list of needed application program functionality. Thus, the Examiner has used impermissible hindsight to reject claims 10-11 as obvious. The Examiner has therefore not established a prima facie case of obviousness.

For at least these reasons, claim 10 is believed to be allowable over the art of record. Claim 11 recites a computer-readable medium having instructions, which when executed, performs the steps of claim 10. Claim 11 is therefore believed to be allowable for at least the same reasons as claim 10. Prompt allowance of claims 10 and 11 is therefore earnestly requested.

Rejections of claims 4-5 under 35 U.S.C. § 102(e)

The examiner rejected claims 4 and 5 as being unpatentable over the Oki patent under 35 U.S.C. § 102(e). Claim 4 has been amended to recite the Applicants' invention more clearly.

As amended, claim 4 recites a method for identifying a set of files and application functionality needed to run the set of files when the computer is disconnected from a network by, in part, identifying a type for each file in the set of files, associating the type with a handler routine, and sending each file to the associated handler routine to identify application functionality needed to run each file. As discussed with respect to claims 1-3, the Oki patent fails to teach or suggest all of the claim elements recited in claim 4.

To expedite prosecution, Applicants further point out that the Oki patent and the Komuro patent as combined fail to teach or suggest identifying a type for each file in the set of files, associating the type with a handler routine, and sending each file to the associated handler routine to identify application functionality needed to run each file.

Claim 4 is believed to be allowable over the art of record for at least these reasons. Claim 5 depends from claim 4 and inherits all the limitations of claim 4, and is therefore believed to be allowable for at least the same reasons as claim 4. Prompt allowance of claims 4 and 5 is therefore earnestly requested.

Conclusion

This amendment is believed to be responsive to all points raised in the Office Action. Claims 1-6, and 8-20 remain pending in the application and are believed to clearly be allowable over the art of record. Accordingly, prompt allowance and passage of the application to issue are earnestly solicited. A separate markup with the claim amendments shown by bracketing and underlining is enclosed with this amendment in accordance with 37 C.F.R. 1.121. Should the Examiner have any remaining questions or concerns, he is encouraged to contact the undersigned attorney by telephone to expeditiously resolve such concerns.

Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Belt et al.	Examiner:	Any, Charles E.
Serial No.:	09/223,595	Group Art Unit:	2151
Filed:	December 30, 1998	Docket No.:	36711.1 60001.99US01
Title:	METHOD AND SYSTEM FOR IDENTIFYING A PROGRAM MODULE FUNCTIONALLY NEEDED BY A COMPUTER WHEN DISCONNECTED FROM A NETWORK		

AMENDMENTS -- MARKUPClaims

1. (Once Amended) A method for identifying application functionality needed to run a set of files when a computer is disconnected from a network, the method comprising the steps of:

for each file in the set of files identifying a handler routine and sending each file to the identified handler routine; and

for each file in the set of files, in the [mapped] identified handler routine, determining the application [program] functionality required to execute each file.

4. A method for identifying a set of files and application functionality needed to run the set of files when the computer is disconnected from a network, the method comprising the steps of:

determining the set of files to be stored locally on the computer;

identifying a type for each file in the set of files;

storing the set of files locally on the computer;

for each file, associating the type with a handler routine;

sending each file to the associated handler routine to identify [identifying]

application functionality needed to run each file; and

installing the identified application functionality locally on the computer.

7. (Cancelled)

8. The method recited in Claim [7] 4, wherein the handler routine comprises instructions for scanning [each] the associated file and determining the application functionality that is needed to execute [each] the associated file.

12. (New) The method of claim 6 wherein the step of determining whether each file found in the plurality of storage locations is to be stored locally is based on a set of rules.

13. (New) The method of claim 6 wherein the step of determining whether each file found in the plurality of storage locations is to be stored locally is based on a user's usage patterns.

14. (New) The method of claim 4 wherein the step of identifying application functionality needed to run each file comprises determining whether each file needs multiple application functionality.

15. (New) The method of claim 14 wherein the step of determining whether each file needs multiple application functionality comprises mapping application functionality to a file embedded in a file in the set of files.

16. (New) The method of claim 15 wherein the embedded file is an Object Linking and Embedding (OLE) object.

17. (New) The method of claim 15 wherein the embedded file is a hyperlink.

18. (New) The method of claim 10 further comprising the steps of:
causing the handler to notify the DME of an embedded file; and
in response to receiving the notification of the embedded file, causing the DME to

transmit the embedded file to another handler associated with the embedded file.

19. (New) The method of claim 10 further comprising the steps of:
sorting the application program functionality according to a frequency of
occurrence.

20. (New) The method of claim 19 wherein the step of sorting the application
program functionality comprises steps of:
causing the handler to return importance rankings associated with the application
program functionality.